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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,627	09/08/2003	Joon Keun Lee	434/1/004	1539

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EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
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1731

MAIL DATE	DELIVERY MODE
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07/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/657,627	Applicant(s) LEE ET AL.	
	Examiner John Hoffmann	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7 June 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, and 3-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As indicated in **MPEP 2173.05(p) II:**

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

It appears that claim 1 (directed to an apparatus) also requires a step of drawing a fiber: the new language refers to "the optical fiber which is...drawn around the movable rollers". Since the claim is directed to neither a process nor a machine, applicant cannot obtain a patent therefore.

Similarly, the following 112 rejection is made:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, and 3-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As discussed above, claim 1 is indefinite because it claims a method step.

Alternatively, it is unclear what the claims requires in regards to the drawing. There is no antecedent basis for "the optical fiber which is in contact with and drawn around the movable rollers and the fixing roller".

As discussed in the previous Office actions, the term "radius" is indefinite as to its meaning. For example see page 4 of the 9/11/2006 rejection. As shown in applicant's figure 3, the loose fiber has a curved surface that is not exactly a circle. If one were to pull the fiber tight, the fiber would not curve between the rollers, it would be nothing like a circle.

Claims 1 and 3-6 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 1 and 3-6 fail(s) to correspond in scope with that which applicant(s) regard

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as the invention can be found in the reply filed 6/7/2007. In that paper (at page 10, lines 10-11), applicant has stated "the moving rollers 18, 19 must be able to move, respectively, in different directions while guiding the fiber", and this statement indicates that the invention is different from what is defined in the claim(s) because the last paragraph of claim one only specifies that the rollers move in one direction.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 3-6 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for moving the rollers in two directions, does not reasonably provide enablement for moving the rollers in only one direction. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The MPEP sets forth what must be considered to establish whether the enablement requirement is met.

2164.01(a) Undue Experimentation Factors

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and

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(H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

Examiner has considered each of these factors. Each is neutral or suggest that the burden would not be undue.

However, superceding all the these factors, is the evidence on page 10 of the June 7 response where applicant admits to make and use the invention, one "must" be able to move the rollers in different directions. But claim 1 clearly is not limited to this, rather is specifically sets forth that the movement need only be "at least one" direction (see above). Applicant cannot have a claim directed to one direction, where the invention "must" have two directions.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida 6519404 and Askins H1268 as applied to claim 1 above, and further in view of Butterworth-Heinemann and Sclater et al.

See the prior Office action for the manner in which the art is applied.

Response to Arguments

Applicant's arguments filed 7 June 2007 have been fully considered but they are not persuasive.

It is argued that Yoshida does not teach the rollers are independently mounted on different brackets. This appears to be true. However, such would have been obvious for the reasons of record.

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IT is further argued that the use of a single guide rail is a teaching away from the separate brackets. Examiner disagrees.

From MPEP 2145:

A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness; however, "the nature of the teaching is highly relevant and must be weighed in substance. A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (Claims were directed to an epoxy resin based printed circuit material. A prior art reference disclosed a polyester-imide resin based printed circuit material, and taught that although epoxy resin based materials have acceptable stability and some degree of flexibility, they are inferior to polyester-imide resin based materials. The court held the claims would have been obvious over the prior art because the reference taught epoxy resin based material was useful for applicant's purpose, applicant did not distinguish the claimed epoxy from the prior art epoxy, and applicant asserted no discovery beyond what was known to the art.)

Yoshida does not teach away from Applicant's claimed invention, or from the prior art combination because the disclosure of this reference does not criticize, discredit, or otherwise discourage the invention or the combination. *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1145-46 (Fed. Cir. 2004).

It is further argued that to achieve applicant's objective, the rollers are moved in different directions, and that Yoshida does not disclose this. 1) Applicant has not reasonably demonstrated that the rollers must be capable of movement in different directions. It seems to Examiner that one could fix the rollers as shown in applicant's figure 3, to get the fiber placement as shown in figure 3. 2) The claims do not require movement in different directions.

It is argued that Examiner has failed to indicate anywhere in the art where there is a suggestion to use two separate brackets. Whereas Examiner did not point to a suggestion in the prior art, such is not really a failure, because Examiner did not attempt to do so, nor is Examiner required to do so. Examiner has provided various motivations. For example, starting on page 5 of the 3/8/07 Office Action.

It is argued that in the present instance there is new and unexpected results. Examiner is not aware of any evidence of such results – only the unsupported assertion thereof.

It is also argued that In re Stevens does not apply because there Stevens requires an art-recognized need. The plain reading of Stevens is that if adjustability is needed, then adjustability is obvious. In the Stevens decision, it is indicated that there was an art-recognized need in that case – but it does not state that the need must be found in the art.

As indicated by the Supreme Court in KSR vs. Teleflex:

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.

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When two wheels need to be mounted, and brackets are used, there is only a finite number of solutions: one bracket for both, or one bracket per wheel. It is of ordinary skill and common sense to use two brackets rather than one.

Applicant does not see the relevance of *In re Dulberg*. Examiner cites on this to show that it is generally not considered invention to be able to make an item into two separable parts. For example, separate one bracket into two.

It is argued that the adjusted curvature radius is shown in figure 3 as being the overall curvature of the optical fiber around all three rollers. Examiner understand that the drawing shows a curve which approximates a circle. Since Examiner is uncertain as to whether applicant now agrees with the Office's broadest reasonable interpretation of this – as it applies to the prior art. And since applicant has previously disputed this interpretation. It is deemed proper for the Office to make the present 112 rejection – since this interpretation may be disputed again – but this time in an Appeal.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

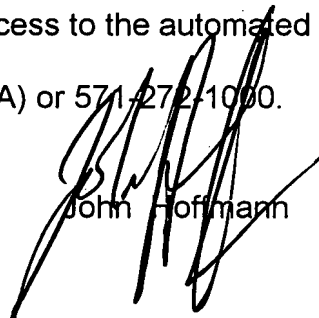
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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


John Hoffmann

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Primary Examiner
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jmh